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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,816	02/19/2002	Mikito Nishii	111970	2904

7590

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Oliff & Berridge  
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EXAMINER

HARDEE, JOHN R

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/049,816

Applicant(s)

NISHII ET AL.

Examiner

John R. Hardee

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 15, 17 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10-14, 16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-6, 8, 10-14, 16 and 18 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot find basis in the specification for the limitation that an “additive comprises at least...about 0.2%.”.
3. Claims 1-6, 8, 10-14, 16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What is a “phosphoric acid compound”, aside from phosphoric acid? What organophosphoric acid compounds” are contemplated? The phosphate ester of the WO is a phosphoric acid derivative but it is also organic-does that make it an organophosphoric acid compound? The newly added language is confusing and self contradictory. This makes it indefinite. How much is “less than about 0.2%”? Does 0.2% meet the limitation? Zero does—did applicant have this in mind when making the amendment? “At least one of at less than or about 0.2%” means that neither need be present, one may be absent or present, but at less than “about 0.2%”, or both may be present at this amount, however much it may be. One

Art Unit: 1751

may be present in any amount, subject to the conductivity limitation, provided the other is present in a lesser amount. It is well settled that "less than" includes zero.

***Claim Rejections - 35 USC § 102***

4. Claims 1-6, 8, 10, 11, 13, 14, 16 and 18 remain rejected under 35 U.S.C. 102(b) as being anticipated by JP 62-045,681 A. See abstract, which discloses a mixture of 5 parts by weight of silicone oil, 95 pbw of ethylene glycol, 3 pbw of triethanolamine, 0.1 pbw of benzotriazole, 0.8 pbw of phosphoric acid and colorant. This is diluted with water to an ethylene glycol concentration of 30%, at which point the phosphoric acid is present at 0.23%, which appears to read on less than about 0.2%. The Office does not have the facilities to determine conductivities, but the ionic concentration appears to be small enough and the glycol concentration large enough to meet applicant's limitations. A cooling cycle of the disclosed coolant and nitrogen can be fairly inferred, as cooling of an engine is the intended purpose of the composition. Silicone oil and ethylene glycol are nonionic. Claim 18 is drawn to intended use, and the product by process limitations of claims 13 and 14 are held to be met in the absence of evidence to the contrary.

5. Claims 1-6, 8, 10, 11, 13, 14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by SU 899,635 B (abstract). See the disclosed composition. Phosphoric acid compounds and organophosphoric acid compounds are absent, and therefore present at less than about 0.2%. The Office does not have the facilities to determine conductivities, but the ionic concentration appears to be small enough at the low end of the concentration ranges to meet applicant's limitations. Claim 18 is drawn to

Art Unit: 1751

intended use, and the product by process limitations of claims 13 and 14 are held to be met in the absence of evidence to the contrary.

6. Claims 1-6, 8, 10-14, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/40441. The reference is in Japanese. See the composition disclosed at col. 5, lines 45+ of related US 6,083,311. It is not clear whether the phosphoric ester is a phosphoric acid compound or an organophosphoric acid compound (see 112, 2<sup>nd</sup> rejection), but whichever one it is not is present at 0%, meeting the newly recited limitation. The Office does not have the facilities to determine conductivities, but the ionic concentration appears to be small enough at the low end of the concentration ranges to meet applicant's limitations. Claim 18 is drawn to intended use, and the product by process limitations of claims 13 and 14 are held to be met in the absence of evidence to the contrary.

### ***Response to Arguments***

7. Applicant's arguments filed June 3, 2005 have been fully considered but they are not persuasive. Applicant argues that basis for the limitations of "less than about 0.2%..." can be found on pages 3 and 7, as well as in Fig. 1. This is not persuasive because the recitation of possible percentage amounts of these materials does not provide basis for the range as recited. Accordingly, the new matter rejection is maintained.

Applicant argues that the specification at p. 7 defines what an organophosphorus acid compound and a phosphoric acid compound are defined at p. 7 of the specification.

Art Unit: 1751

This is not persuasive because the cited passages discuss phosphoric acids and organophosphoric acids, but not what *compounds* of these materials might be. The examiner has cited art which discloses compounds comprising phosphoric acid esters. In the absence of guidance from the specification, the examiner has relied upon the "broadest reasonable" definition of such a compound, that being a compound made from a phosphoric acid or organophosphoric acid starting material.

As noted in the rejection above and in the previous office action, "less than about" reads on zero, and "one or more at less than about" reads on zero amounts of both or zero to "about 0.2%" of one and any amount of the other, subject to the conductivity limitation. As a phosphoric acid ester would not be charged (and therefore non-conductive), large amounts of such esters can be tolerated. Applicant's arguments that references disclosing zero amounts of both components are not pertinent simply confuses matters further.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 1751

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "J. Mardee", with a stylized, cursive script.

John R. Mardee

Primary Examiner

July 18, 2005